

## **REMARKS/ARGUMENTS**

### **Rejections under 35 U.S.C. § 112:**

Examiner rejected Claims 10-13, 15-19, 24-28, and 30 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner also indicated Claims 10-13, 15-19 would be allowable if amended to overcome the rejection under 35 U.S.C. §112, second paragraph. Applicant has amended Claims 10-13, 15-19, 24-28, and 30 to more clearly define the present invention.

### **Rejections under 35 U.S.C. § 102(b):**

Examiner rejected Claims 1-3, 5, and 9 under 35 U.S.C. §102(b) as being anticipated by Hart et al., U.S. Patent Number 5,618,304 (“Hart”), and claims 21, 22, 24-27, 29 and 30 under 35 U.S.C. §102(b) as being anticipated Antebi, U.S. Patent Number 4,592,355 (“Antebi”). “To anticipate, every element and limitation of the claimed invention must be found in a single prior art of reference, arranged as in the claim.” *Brown v. 3M*, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (*citing Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291(Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991)).

With respect to the rejection of Claims 1-3, 5, and 9 as being anticipated by Hart, Applicant respectfully submits that Hart does not disclose every element as arranged in present Claim 1. In particular, the following element of Claim 1 is not disclosed in Hart:

“an elongated inner rod having a proximal end, a distal end and a longitudinal protrusion wherein said distal end comprises a mechanism for releasably engaging a gastric band”

Examiner characterizes “insulator housing” 42 of Hart as being an elongated inner rod as in present Claim 1. In present Claim 1, the distal end of the elongated inner rod also “comprises a mechanism for releasably engaging a gastric band.” In contrast, the insulator housing 42 of Hart

includes no such mechanism at its distal end (see, e.g., Fig. 5 and Fig. 6 of Hart). Therefore, Hart does not disclose the elongated inner rod of present Claim 1. For at least this reason, Applicant respectfully requests the rejection under 35 U.S.C. §102(b) of Claim 1, and Claims 2, 3, 5 and 9 by virtue of their dependence from Claim 1, be withdrawn.

With respect to the rejection of Claims 21 and 22 as being anticipated by Antebi, Applicant has amended Claim 21 to more clearly define the invention. Antebi does not disclose “an elongated support tube having...an open distal end sized to encompass an adjustable gastric band”. For at least this reason, Applicant respectfully submits that Claims 21-22 are in condition for allowance.

With respect to the rejection of Claims 24-27 as being anticipated by Antebi, Applicant respectfully submits that Antebi does not disclose every element and limitation of present Claim 24. In particular, Antebi fails to disclose “a gastric band releasably secured to said shelf...wherein said distal movement of said rod exposes said gastric band”. Rather, Antebi discloses a tie 10, for facilitating the necrosis of bulging hemorrhoidal tissue, releasably secured to the distal end of an extension 21 and the distal end of a rod 30, where proximal movement of the rod 30 tightens the tie 10 after it has been looped about bulging hemorrhoidal tissue. Examiner characterizes extension 21 of Antebi as being an elongated inner rod as in Claim 24, yet, in Antebi, distal movement of the extension 21 does not *expose* the tie 10. Therefore, for at least these reasons, Applicant respectfully requests the rejection under 35 U.S.C. §102(b) of Claim 24, and Claims 25-27 by virtue of their dependence from Claim 24, be withdrawn.

With respect to the rejection of Claim 29 as being anticipated by Antebi, Applicant respectfully submits that Antebi does not disclose every element and limitation of present Claim 29. In particular, Antebi fails to disclose “an adjustable gastric band”. Rather, Antebi discloses a tie 10 for facilitating the necrosis of bulging hemorrhoidal tissue.

In further particular, the following element of Claim 29 is not disclosed in Antebi:

“an elongated support tube having a proximal end and an open distal end sized to encompass the adjustable gastric band”

Claim 29 further includes that the mechanism of the elongated inner rod “retains the adjustable gastric band in the elongated support tube” when the inner rod is at a “proximal position” and

that the “mechanism and at least a portion of the adjustable gastric band” is exposed when the inner rod is at a “distal position”. Examiner characterizes the holder 22 of Antebi as being an elongated support tube as in Claim 29 and extension 21 of Antebi as being an elongated inner rod as in Claim 29. Antebi discloses a tie 10, for facilitating the necrosis of bulging hemorrhoidal tissue, releasably secured to the distal end of an extension 21 and the distal end of a rod 30, where proximal movement of the rod 30 tightens the tie 10 after it has been looped about bulging hemorrhoidal tissue. Further, the distal end of the holder 22 of Antebi is not sized to encompass an adjustable gastric band or a mechanism releasably engaged to an adjustable gastric band (see e.g. Fig. 3 and Fig. 4). Therefore, the holder 22 of Antebi is not capable of retaining an adjustable gastric band therein, or a mechanism releasably engaged to an adjustable gastric band therein, when the extension 21 is at a proximal position, and, thus, distal movement of the extension 21 could not *expose* at least a portion of an adjustable gastric band or a mechanism releasably engaged to an adjustable gastric band. Hence, Antebi does not disclose every element and limitation of present Claim 29. For at least these reasons, Applicant respectfully requests the rejection of Claim 29 under 35 U.S.C. §102(b) be withdrawn.

With respect to the rejection of Claim 30 as being anticipated by Antebi, Applicant respectfully submits that Antebi does not disclose every element and limitation of present Claim 30. In particular, Antebi fails to disclose “an adjustable gastric band comprising a trailing conduit”. Rather, Antebi discloses a tie 10 for facilitating the necrosis of bulging hemorrhoidal tissue which has no trailing conduit.

In further particular, the following element of Claim 30 is not disclosed in Antebi:

“an elongated support tube sized to encompass said trailing conduit of said adjustable gastric band, said elongated support tube also having a proximal end and an open distal end sized to encompass said adjustable gastric band”

Claim 30 also includes that the “adjustable gastric band is retained in said elongated support tube” when the inner rod is at a “proximal position” and that “at least a portion of said adjustable gastric band” is exposed when the inner rod is at a “distal position”. Examiner characterizes the holder 22 of Antebi as being an elongated support tube as in Claim 30 and extension 21 of Antebi as being an elongated inner rod as in Claim 30. Antebi discloses a tie 10, for facilitating the necrosis of bulging hemorrhoidal tissue, releasably secured to the distal end of an extension

21 and the distal end of a rod 30, where proximal movement of the rod 30 tightens the tie 10 after it has been looped about bulging hemorrhoidal tissue. Further, the distal end of the holder 22 of Antebi is not sized to encompass an adjustable gastric band having a trailing conduit (see e.g. Fig. 3 and Fig. 4). Therefore, the holder 22 of Antebi is not capable of retaining an adjustable gastric band having a trailing conduit therein when the extension 21 is at a proximal position, and, thus, distal movement of the extension 21 could not *expose* at least a portion of an adjustable gastric band. Hence, Antebi does not disclose every element and limitation of present Claim 30. For at least these reasons, Applicant respectfully requests the rejection of Claim 30 under 35 U.S.C. §102(b) be withdrawn.

**Rejections under 35 U.S.C. § 103(a):**

Examiner rejected Claims 6-8 under 35 U.S.C. §103(a) as being unpatentable over Hart. Given that Hart fails to disclose each element of Claim 1, *supra*, and given that Claims 6-8 are dependent from Claim 1 (i.e. Applicant is not claiming ranges for lengths and diameters in and of themselves), Applicant respectfully requests the rejection of Claims 6-8 under 35 U.S.C. §103(a) be withdrawn.

**Allowable Claims:**

Applicant acknowledges with appreciation Examiner's indication that Claims 10-19 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. §112, second paragraph. Applicant believes the current amendments place Claims 10-19 in condition for allowance.

Applicant also acknowledges with appreciation Examiner's indications that Claim 20 is allowable over the prior art of record.

Applicant acknowledges with appreciation Examiner's indication that Claim 23 would be allowable if rewritten in independent form. Applicant has rewritten Claim 23 in independent form including all of the limitations of the original base Claim 21 and submits such as new Claim 31.

**Conclusion:**

Claims 1-3, 5-9, 10-13, 15-19, and 20-30 remain in this application and are believed to be in condition for allowance. Applicant acknowledges with appreciation Examiner's indication that Claims 10-19 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. §112, second paragraph. Applicant believes the current amendments place Claims 10-19 in condition for allowance. Applicant also acknowledges with appreciation Examiner's indications that Claim 20 is allowable over the prior art of record.

Claim 21 has been amended to more clearly define the invention and is believed to be in condition for allowance. Claims 22 and 23 are also believed to be in condition for allowance by virtue of their dependence on Claim 21. Claims 29 and 30 have been amended to more clearly define the invention and correct typographical errors. Applicant believes the current amendments place Claims 29 and 30 in condition for allowance.

Applicant acknowledges with appreciation Examiner's indication that Claim 23 would be allowable if rewritten in independent form. Applicant has rewritten Claim 23 in independent form including all of the limitations of the original base Claim 21 and submits such as new Claim 31. New Claim 32 is also submitted. Applicant submits that none of the prior art of record discloses or suggests the combination of elements claimed in Claim 32.

Accordingly, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, this 12<sup>th</sup> day of December, 2005.

